

Application No.: 10/698,757

Docket No.: 66022-0029

REMARKS

Applicants have carefully reviewed the Office Action mailed April 19, 2005, and thank Examiner Ahmad for the detailed review of the pending claims. In response to the Office Action, Applicants have amended claim 1, canceled claims 9-30, and added new claims 31-42. By way of this amendment, no new matter has been added. Accordingly, claims 1-8 and 31-42 remain pending in this application. Applicants respectfully request reconsideration of the present application in view of the above amendment and the following remarks.

ELECTION

Applicants elect Group I as identified by the Examiner, consisting of claims 1-8 for examination. Applicants hereby cancel non-elected claims 9-30 without prejudice. New claims 31-42 read on the embodiment of Group I.

Claim Rejections – 35 U.S.C. § 103

Claims 1-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sweet* (U.S. Patent 5,830,549) in view of *Iwata* (5,554,429). Applicants respectfully traverse the rejection.

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facie obviousness as follows: "To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The Examiner has combined the "wood portion (25) including a first side and a second side, a protective layer (23), and a first adhesive (21) disposed between the protective layer and one side of the wood portion" of *Sweet* with the teachings of *Iwata*. However, the

Application No.: 10/698,757

Docket No.: 66022-0029

"first adhesive (21)" of Sweet is taught as "extremely robust, and even a short time after application, the adhesive 21 is sufficiently tenacious that trying to remove the flooring strip 10 by pulling up one end results in the flooring strip 10 splintering and breaking before the adhesive 21 releases." (Column 5, lines 29-33). Thus, the adhesive 21 of Sweet does not release from the flooring strip 25 after application. Indeed, Sweet does not teach *any* adhesives that *temporarily* adhere to wood. Accordingly, Sweet does not teach every element of independent claim 1, but in fact teaches away from Applicants' claimed invention embodied in claim 1. Nor does Iwata teach any adhesives that temporarily adhere to wood.

As further support that Sweet does not obviate independent claim 1, Applicants note that Sweet provides that a "sheet of release paper 23 remains adhered to the other side of the adhesive layer 21 and protects the adhesive 21 until the flooring strip 10 is ready to be applied to the subfloor." (Column 4, lines 44-47). Thus the "protective layer (23)" of Sweet is not taught as protecting the wood as asserted in the office action, but rather the adhesive, whereas the claimed invention requires the protective layer to protect the wood.

In contrast to the prior art, amended independent claim 1 positively recites that "the first adhesive is at least partially retained on the protective layer as the protective layer is removed from the wood portion." Thus, the first adhesive is provided to temporarily adhere to the wood portion and be removable when desired, whereas the adhesive 21 of Sweet is taught to robustly adhere to wood. Accordingly, claim 1 is not obviated by the prior art.

Dependent claims 2-8 teach independently patentable subject matter, although they are also patentable merely by being dependent on an allowable base claim. For example, claim 2 recites "wherein the attachment strength of the first adhesive relative to the wood portion is less strong than the attachment strength of the second adhesive relative to the wood portion." In contrast, the above cited passage of Sweet from column 5 indicates that the adhesive 21 of Sweet provides the strongest bond between any other materials. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection.

New Claims

Newly added independent claim 31 includes the limitation "a roll of a wood portion, the wood portion including a first side and a second side, wherein at least a portion of the first

Application No.: 10/698,757

Docket No.: 66022-0029

side is facing at least a portion of the second side". The prior art of record does not teach or suggest a roll of edge band material. Newly added independent claim 36 includes the limitations "a stain disposed on or within the first side", and "a first adhesive that is disposed between the protective layer and the first side of the wood portion." The prior art of record does not teach or suggest an edge band with a stain and a first adhesive on a first side. Dependent claims 32-35 and 37-42 contain limitations in addition to the limitations of their respective base claims. Accordingly, it is asserted that the newly added claims are also in condition for allowance.

CONCLUSION

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 66022-0029 from which the undersigned is authorized to draw.

Dated: July 19, 2005

Respectfully submitted,

By 

Kristin L. Murphy

Registration No.: 41,212

Kenneth W. Jarrell

Registration No.: 52,484

RADER, FISHMAN & GRAUER PLLC

39533 Woodward Avenue

Suite 140

Bloomfield Hills, Michigan 48304

(248) 594-0647

Attorneys for Applicant

R0296153.DOC